

**REMARKS**

Claims 1-47 and 49-66 are presently pending in the application. New claim 66 has been added in this response.

In the Office Action mailed August 16, 2006, claims 1-47 and 49-65 were rejected. More specifically, the status of the application in light of this Office Action is as follows:

(A) Claims 1-7, 11, 14, 16-18, 20-23, 26, 27, 29-32, 34-40, 43-45, 49, 51-54, 57-59, and 61-65 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of U.S. Patent No. 6,173,274 to Ryan ("Ryan") and International Publication No. WO 96/29263 to Giacomozzi ("Giacomozzi");

(B) Claims 8, 9, 24, 28, 42, and 56 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Ryan, Giacomozzi, and U.S. Patent No. 5,473,863 to Itkonen ("Itkonen");

(C) Claims 10, 25, 33, 41, 55, 60, and 64 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Ryan, Giacomozzi, and U.S. Patent No. 5,035,515 to Crossman et al. ("Crossman"); and

(D) Claims 12, 13, 15, 19, 46, 47, and 50 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Ryan, Giacomozzi, and U.S. Patent No. 6,421,652 to Loeb et al. ("Loeb").

A. Response to the Section 103(a) Rejection Over Ryan and Giacomozzi

Claims 1-7, 11, 14, 16-18, 20-23, 26, 27, 29-32, 34-40, 43-45, 49, 51-54, 57-59, and 61-65 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Ryan and Giacomozzi. As set forth in detail below, Ryan and Giacomozzi cannot support a Section 103(a) rejection of these claims because (a) these reference, alone and in combination, fail to disclose or suggest all the features these claims, and (b) there is no motivation to combine these references.

1. Claim 1 is Directed to a Computer System for Processing a Paper Product Including a Promotions Order Tracker Configured to Receive a Promotional Material Order From a Third-Party Advertiser to Place Promotional Material on an Enclosure for the Paper Product

Claim 1 is directed to a computer system for processing a paper product. The computer system includes a product order tracker configured to receive a paper product order from a paper purchaser to purchase a paper product that is produced by a paper manufacturer. The paper product includes a roll of paper or a plurality of unbound, stacked paper sheets. The computer system further includes a promotions order tracker configured to receive a promotional material order from a third-party advertiser to place promotional material on an enclosure for the paper product. The computer system also includes a paper product tracker configured to provide instructions for creating the enclosure for the paper product. The enclosure has the promotional material of the received promotional material order. The paper product tracker is also configured to provide instructions to enclose the paper product of the received order with the created enclosure. The paper manufacturer, the paper purchaser, and the third-party advertiser are different entities, and the third-party advertiser pays to have the promotional material placed on the enclosure of the paper product.

2. Ryan Discloses a Production Mail System for Printing Advertisements on Envelopes Addressed to a Specific Targeted Audience

Ryan discloses a production mail system for printing advertisements on envelopes addressed to a specific targeted audience. The mail system includes a data processing system with user profiles, an advertiser database, and an address demographics database. The user profiles enable each user to set parameters for controlling third-party advertising on their respective envelopes. For example, each user profile includes an indication of whether the user allows third-party advertising and, if so, a list of preferred third-party advertisers. The advertiser database includes restriction data with information about the targeted audience. For example, the restriction data may include information related to the income, age, education level, marital status, and/or ethnicity of the targeted

audience. The address demographics database includes demographic information for various geographic regions of the country.

During operation, the user submits a mailing list to the data processing system for processing. The mailing list includes multiple recipient addresses to which the user wishes to send mail pieces. The data processing system reviews the mailing list and determines which recipients can have advertisements printed on their envelopes. The data processing system also selects advertisements for each specific recipient based on the advertiser's restriction data, the recipient's address, and the demographic information in the address demographics database. As a result, a specific advertisement is printed on each envelope to ensure that the advertisements are sent to the advertiser's targeted audience.

3. Giacomozzi Discloses Wrappers with Advertising Surfaces for Paper Handkerchiefs

Giacomozzi discloses two embodiments of wrappers containing paper handkerchiefs. In the first embodiment illustrated in Figure 1, the wrapper is "of the soft and transparent kind" and includes an opening. (Giacomozzi, p. 2, Ins. 5-6.) The handkerchiefs are folded and placed in the pocket-sized wrapper so that an individual can retrieve a folded handkerchief through the opening. In the second embodiment illustrated in Figure 2, the wrapper is "of the rigid and opaque kind" and includes a slit. (Giacomozzi, p. 2, In. 10.) The handkerchiefs appear to be folded with adjacent handkerchiefs folded partially together so that retrieving one handkerchief from the wrapper draws a second handkerchief partially out of the wrapper to facilitate retrieval of the second handkerchief. In both embodiments, the wrapper includes a plurality of surfaces having images and/or promotional messages that are not linked to the handkerchiefs.

4. Ryan and Giacomozi Fail to Disclose or Suggest a Computer System for Processing a Paper Product Including a Promotions Order Tracker Configured to Receive a Promotional Material Order from a Third-Party Advertiser to Place Promotional Material on an Enclosure for the Paper Product

Ryan and Giacomozi fail to disclose or suggest a computer system including, *inter alia*, "a promotions order tracker configured to receive a promotional material order from a third-party advertiser to place promotional material on an enclosure for the paper product" in which the paper product includes "a roll of paper or a plurality of unbound, stacked paper sheets," as recited in claim 1. In the Office Action, the Examiner correctly notes that "Ryan does not expressly teach that the paper product includes a roll of paper or a plurality of unbound, stacked paper sheets." (Office Action, p. 3.) The Examiner alleges, however, that "it would have been obvious to a person of ordinary skill in the art . . . [to use] Ryan's system to print promotional materials into the wrappers of paper products (i.e. paper handkerchiefs), as taught by Giacomozi." (Offfce Action, p. 3.) Applicant respectfully disagrees for the reasons set forth below.

One of ordinary skill in the art would not be motivated to modify Ryan's system and print promotional material onto Giacomozi's wrappers because Ryan teaches away from placing promotional material on Giacomozi's wrappers. Specifically, Ryan teaches away from placing promotional material on items when "the third party advertiser cannot exercise any control over who receives the message." (Ryan, col. 2, Ins. 65-66.) Thus, Ryan teaches away from placing promotional material on Giacomozi's wrappers because the advertiser cannot exercise any control over who receives the message. Rather, the message is received by random individuals who either purchase Giacomozi's handkerchief packages or notice the promotional message on one of Giacomozi's handkerchief packages. This is precisely the type of advertising Ryan's invention is designed to avoid. As the Examiner correctly notes, Ryan's invention is directed at "resolv[ing] this problem by giving advertisers control over targeting their messages." (Office Action, p. 10.) Accordingly, the Examiner's suggested use of Ryan's system to print promotional material onto Giacomozi's wrappers contravenes one purpose of Ryan's

invention—overcoming the disadvantage of conventional advertising campaigns in which "the third party advertiser has no assurance that a target audience would be reached." (Ryan, col. 2, ln. 67 – col. 3, ln. 1.) Therefore, one skilled in the art would not be motivated to modify Ryan's system and print promotional material onto Giacomozi's wrappers.

"The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992) (emphasis added). Moreover, and importantly in the present case, a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would teach away from the claimed invention. *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). In this case, the Examiner has simply picked and chosen various elements from the prior art and put them together without consideration of operability or desirability. In doing so, the Examiner has ignored the teachings of Ryan and combined Ryan with Giacomozi in such a way that thwarts one purpose of Ryan's invention.

The rejection of claim 1 should be withdrawn for the additional reason that the combination of Ryan and Giacomozi fails to disclose or suggest a computer system including, *inter alia*, "a product order tracker configured to receive a paper product order from a paper purchaser to purchase a paper product that is produced by a paper manufacturer, the paper product including a roll of paper or a plurality of unbound, stacked paper sheets," as recited in claim 1. In the Office Action, the Examiner alleges that Ryan discloses "a product order tracker configured to receive a paper product order from a paper purchaser (see "commercial user" column 9, lines 1-5) to purchase a paper product that is produced by a manufacturer (see column 8, lines 35-40)." (Office Action, p. 2.) This is incorrect. Nowhere does Ryan mention the product order tracker of claim 1. For example, Ryan does not discuss a paper manufacturer at column 8, lines 35-40, and the commercial user described at column 9, lines 1-5 of Ryan is the user of the production mail

system. Accordingly, the combination of Ryan and Giacomozi fails to disclose or suggest all the features of claim 1.

The current rejection of claim 1 over the combination of Ryan and Giacomozi does not comply with Section 103(a) because (a) the applied art fails to disclose or suggest all the features of this claim, and (b) one skilled in the art would not be motivated to modify Ryan's system and print promotional material onto Giacomozi's wrappers. As explained above, Ryan teaches away from placing promotional material on items when "the third party advertiser cannot exercise any control over who receives the message." (Ryan, col. 2, lns. 65-66.). Accordingly, the Section 103(a) rejection of claim 1 should be withdrawn.

Claims 2-7 depend from claim 1. Accordingly, the Section 103(a) rejection of claims 2-7 should be withdrawn for at least the reasons discussed above with reference to claim 1 and for the additional features of these claims.

Independent claims 11, 18, 22, 26, 31, 34, 49, 52, 57 and 61 have, *inter alia*, features generally analogous to those included in claim 1. Accordingly, the Section 103(a) rejection of claims 11, 18, 22, 26, 31, 34, 49, 52, 57 and 61 should be withdrawn for at least the reasons discussed above with reference to claim 1 and for the additional features of these claims.

Claims 14, 16, 17, 20, 21, 23, 27, 29, 30, 32, 35-40, 43-45, 51, 53, 54, 58, 59 and 62-65 depend from one of the independent claims listed above. Accordingly, the Section 103(a) rejection of these claims should be withdrawn for at least the reasons discussed above with reference to their respective independent claims and for the additional features of these dependent claims.

B. Response to the Section 103(a) Rejection over Ryan, Giacomozi, and Itkonen

Claims 8, 9, 24, 28, 42 and 56 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Ryan, Giacomozi, and Itkonen. Claims 8, 9, 24, 28, 42 and 56 depend from independent claims that have, *inter alia*, features generally

analogous to those included in claim 1. Accordingly, claims 8, 9, 24, 28, 42 and 56 are patentable over Ryan and Giacomozi for at least the reasons discussed above with reference to claim 1 and for the additional features of these claims. Moreover, Itkonen fails to cure the above-noted deficiencies of Ryan and Giacomozi to properly support a *prima facie* case of obviousness under Section 103(a). For example, Itkonen fails to provide a motivation to modify Ryan's system and print promotional material onto Giacomozi's wrappers. To the contrary, Itkonen discloses placing the factory label on a plastic wrap for a paper roll. Accordingly, the Section 103(a) rejection of claims 8, 9, 24, 28, 42 and 56 should be withdrawn.

C. Response to the Section 103(a) Rejection over Ryan, Giacomozi, and Crossman

Claims 10, 25, 33, 41, 55, 60 and 64 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ryan, Giacomozi, and Crossman. Claims 10, 25, 33, 41, 55, 60 and 64 depend from independent claims that have, *inter alia*, features generally analogous to those included in claim 1. Accordingly, claims 10, 25, 33, 41, 55, 60 and 64 are patentable over Ryan and Giacomozi for at least the reasons discussed above with reference to claim 1 and for the additional features of these claims. Moreover, Crossman fails to cure the above-noted deficiencies of Ryan and Giacomozi to properly support a *prima facie* case of obviousness under Section 103(a). For example, Crossman fails to provide a motivation to modify Ryan's system and print promotional material onto Giacomozi's wrappers. To the contrary, Crossman discloses packaging having a detachable coupon compartment. Accordingly, the Section 103(a) rejection of claims 10, 25, 33, 41, 55, 60 and 64 should be withdrawn.

D. Response to the Section 103(a) Rejection over Ryan, Giacomozi, and Loeb

Claims 12, 13, 15, 19, 46, 47 and 50 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ryan, Giacomozi, and Loeb. Claims 12, 13, 15, 19, 46, 47 and 50 depend from independent claims that have, *inter alia*, features generally analogous to those included in claim 1. Accordingly, claims 12, 13, 15, 19, 46, 47 and 50 are patentable over Ryan and Giacomozi for at least the reasons discussed above with reference to

claim 1 and for the additional features of these claims. Moreover, Loeb fails to cure the above-noted deficiencies of Ryan and Giacomozi to properly support a *prima facie* case of obviousness under Section 103(a). For example, Loeb fails to provide a motivation to modify Ryan's system and print promotional material onto Giacomozi's wrappers. To the contrary, Loeb discloses that 60% of all new subscriptions are acquired by third-party service providers known as agents. Accordingly, the Section 103(a) rejection of claims 12, 13, 15, 19, 46, 47 and 50 should be withdrawn.

E. New Claim 66

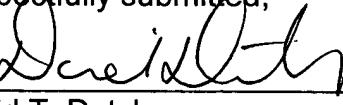
New claim 66 is directed to the computer system of claim 1 wherein the product order tracker is configured to receive a paper product order for unbound, stacked, unfolded sheets of paper. Therefore, new claim 66 is patentable over the applied art for at least the reasons described above with reference to claim 1 and for the additional features of claim 66. Moreover, even if Ryan's system were modified to print promotional material onto Giacomozi's wrappers, Ryan's modified system would not include all the features of claim 66 because Giacomozi's handkerchiefs are folded in both disclosed embodiments. Specifically, in the first embodiment illustrated in Figure 1, Giacomozi's handkerchiefs are folded to fit within the pocket-sized wrapper. If the handkerchiefs were not folded, the handkerchiefs would not fit within the wrapper. In the second embodiment illustrated in Figure 2, the handkerchiefs appear to be folded with adjacent handkerchiefs folded partially together so that retrieving one handkerchief from the wrapper draws a second handkerchief partially out of the wrapper to facilitate retrieval of the second handkerchief. If the handkerchiefs were not folded, it would be difficult to retrieve a handkerchief from the wrapper. Accordingly, even if Ryan's system were modified as suggested by the Examiner, the modified system would not include all the features of claim 66. Therefore, claim 66 is patentable over the applied art for at least the reasons discussed above with reference to claim 1 and for this additional reason.

F. Conclusion

In view of the foregoing, the pending claims comply with 35 U.S.C. § 112 and are patentable over the applied art. The applicant accordingly requests reconsideration of the application and a Notice of Allowance. If the Examiner has any questions or believes a telephone conference would expedite prosecution of this application, the Examiner is encouraged to contact David Dutcher at (206) 359-6465.

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Respectfully submitted,

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